

**REMARKS/ARGUMENTS**

Claims 1-33 are pending in the present application after this amendment adds claims 30-33. Claims 1, 6 and 7 have been amended. The amendments do not add new matter and find support throughout the Specification and Figures. In particular, the reference to an "implantable medical device" finds support at least in the Specification at page 6, line 22, *et seq.*

Claim 10-29 have been withdrawn as the result of an earlier restriction requirement. In view of the examiner's earlier restriction requirement, Applicant retains the right to present claims 10-29 in a divisional application. Claims 1-6, 8 and 9 stand rejected under 35 U.S.C. § 102(b). Claim 7 stands rejected under 35 U.S.C. § 103(a). It is respectfully submitted that all of the presently pending claims are allowable for at least the following reasons.

**35 U.S.C. § 102(b)**

Claims 1-6, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by P.K. Wu, et al., "The Deposition, Structure, Pattern Deposition, and Activity of Biomaterial Thin-films by Matrix-assisted Pulsed-laser Evaporation (Maple) and Maple Direct Write," (the Wu reference). Applicant respectfully submits that claims 1-6, 8 and 9 are in condition for allowance, for at least the following reasons.

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that **each and every claim limitation is identically disclosed** in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131. Applicant respectfully submits that the Wu reference does not disclose each and every element of the claimed invention.

Amended independent claim 1 relates to a method for coating at least a portion of at least one implantable medical device which includes, among other things, directing an energy beam at a frozen target and vaporizing at least a portion of the frozen target with the energy beam into a vapor. The frozen target includes an agent. The method according to claim 1 also includes contacting the at least one implantable medical device with the vapor.

Applicant respectfully submits that the Wu reference does not discuss, or even suggest, a method of coating an implantable medical device or contacting an implantable

medical device with a vapor. The Examiner apparently relies on a discussion of depositing biomaterials and fabrication of biosensors in the Wu reference as disclosing Applicant's recited method. (Office Action; page 2, sec. 3, citing Wu). However, there is no discussion, or even suggestion, in the Wu reference of coating an implantable medical device using a method according to claim 1, nor any suggestion of contacting an implantable medical device with a vapor, as recited in amended claim 1. Wu apparently relates to biosensors, and in particular a "dopamine electrochemical sensor". (Wu; Abstract). The problems addressed by the Wu reference, namely, adhesion and material compatibility, immobilization, and a protective layer (Wu; sec. 2; Biosensor fabrication), are completely different from the problems associated with implantable medical device coatings, namely, uniform, defect free, thin coatings (Specification; page 1, line 7 to page 2, line 21). Since the Wu reference does not disclose, or even suggest, coating an implantable medical device, nor more particularly contacting an implantable medical device with a vapor, the Wu reference does not anticipate the subject matter of amended claim 1.

Claims 2-6, 8 and 9 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §102(b) with respect to claims 1-6, 8 and 9 is hereby respectfully requested.

### **35 U.S.C. § 103(a)**

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu. Applicant respectfully submits that claim 7 is in condition for allowance for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art **teach or suggest each element of the claim**, but the prior art must also **suggest combining the elements in the manner contemplated by the claim**. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some **suggestion or motivation**, either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art, **to modify or combine the references** and that, when so modified or combined, the prior art **teaches or suggests all of the claim limitations**. M.P.E.P. §2143. Applicant respectfully submits that these criteria for obviousness are not met here.

Claim 7 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable.

Additionally, amended claim 7 recites the feature of directing a gas flow to transport the vapor to the at least one implantable medical device.

Although the Examiner admits that the Wu reference does not teach a method including the feature of directing a gas flow to transport the vapor to the at least one implantable medical device, the Examiner asserts that this feature is obvious. (Office Action; page 3, sec. 5).

It is respectfully submitted that there is no suggestion in the prior art to modify the Wu reference in order to arrive at the invention of claim 1. In In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the Federal Circuit considered a claim directed to a method of automatically displaying functions of a video display device. In rejecting the obviousness rejection based on a combination of two references, the In re Lee Court stated that the Examiner's "conclusory" statements regarding motivation to combine "do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." Id. at 1434. According to the In re Lee Court, the rejection by the Board of Appeals of the need for any specific hint or suggestion in a particular reference amounted to an "[o]mission of a relevant factor" justifying reversal. Id. at 1435. The In re Lee Court further added that the "common knowledge and common sense" standard on which the Board of Appeals relied, "even if assumed to derive from the agency's expertise, [does] not substitute for authority when the law requires authority." Id.

The Examiner asserts that it would have been obvious to modify the Wu reference. Specifically, the Examiner states that "it would have been obvious to one of ordinary skill in the art to enhance the flow of the target coating by directing it to the desired substrate using a suspending gas stream." (Office Action; page 3, sec. 5). However, according to the Court in In re Lee, this type of conclusory reasoning for the modification of a reference is insufficient

to sustain an obviousness rejection. The Wu reference relates to a method of fabricating a biosensor. The only motivation to modify the reference comes from the disclosure of the Applicant, which constitutes improper hindsight reasoning. Since the Office Action admits that the Wu reference does not teach a gas flow, the reference fails to pass the threshold issue recited by the court in Northern Telecom, *i.e.* that the prior art teach or suggest each element of the claim. Since the Wu reference does not teach each element of claim 7, and since there is no motivation or suggestion to modify the reference, the reference does not render the subject matter of claim 7 obvious.

For at least the reasons discussed above, withdrawal of the rejections under 35 U.S.C. §103(a) with respect to claim 7 is hereby respectfully requested.

#### **New Claims**

Claims 30-33 ultimately depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable. Additionally, claim 30 recites the feature that the vapor forms a coating on the portion of the implantable medical device. It is respectfully submitted that the Wu reference provides no suggestion of providing a coating on an implantable medical device. Therefore, it is respectfully submitted that claim 30 is allowable.

Similarly, claim 31 recites the feature that another portion of the implantable medical device is not coated. It is respectfully submitted that the Wu reference provides no suggestion that another portion of the implantable medical device is not coated. Therefore, it is respectfully submitted that claim 31 is allowable.

Likewise, claim 32 recites the feature that another portion of the implantable medical device is coated with another agent. It is respectfully submitted that the Wu reference provides no suggestion that another portion of the implantable medical device is coated with another agent. Therefore, it is respectfully submitted that claim 32 is allowable.

Finally, claim 33 recites the feature that the portion of the implantable medical device that is coated is at least one end of an implantable medical device. It is respectfully submitted that the Wu reference provides no suggestion that the portion of the implantable medical device that is coated is at least one end of an implantable medical device. Therefore, it is respectfully submitted that claim 33 is allowable.

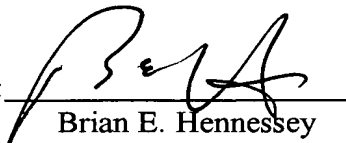
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**CONCLUSION**

Applicant respectfully submits that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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